

REMARKS

Claims 1-7, 10-24 and 40-42 are pending in the subject application. The Examiner's indication that claims 12-15, 17, 18, 23, 24 and 41 recite allowable subject matter is acknowledged with appreciation. Applicant respectfully traverses the objection to the specification and the rejection of claims 1-7, 10, 11, 16, 19-22, 40 and 42 for the reasons below.¹

Objection to the Specification

In the Office Action, the Examiner objected to the specification for allegedly failing to provide support for the "tangible recording medium" recited in claim 40. Applicant disagrees. There is no requirement that the specification describe the claimed subject matter in exactly the same terms as used in the claims; it must simply show that Applicant had invented what is claimed at the time the application was filed. (*See Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995), *citations omitted*; M.P.E.P. § 2163.02.)

Paragraph 0077 of the specification in Applicant's published application recites, "The computer readable recording media includes storage media such as magnetic storage media (e.g., ROM's, floppy disks, hard disks, etc.), and optically readable media (e.g., CD-ROMs, DVDs, etc.). Also, the computer readable recording media can be scattered on computer systems connected through a network and can store and execute a computer readable code in a distributed mode." Magnetic storage media, such as ROM's, floppy disks, hard disks are tangible recording mediums. Accordingly "tangible recording medium" recited in claim 40 has antecedent basis in the specification and provides sufficient support to satisfy 35 U.S.C. § 112, first paragraph. Applicant, therefore, requests that the Examiner reconsider and withdraw the objection to the specification.

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

Rejection Under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claim 1 under 35 U.S.C. §103(a) as allegedly not being patentable over U.S. Patent No. 6,628,822 to *Nakabayashi et al.* ("*Nakabayashi*"). Claim 1 recites, *inter alia*, "making the predetermined illumination characteristic data into a data format comprising a type block and an illuminance block, wherein the type block indicates information on a type of illumination, and the illuminance block indicates information on the illuminance of illumination." The Examiner concedes that *Nakabayashi* does not disclose or suggest these features of claim 1, but asserts that they would be obvious. (Office Action, p. 4.) Applicant respectfully disagrees.

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, No. 04-1350 (U.S., April 30, 2007), 82 USPQ2d 1385, 1395 (2007); M.P.E.P. § 2143.02.) The Office Action fails in these regards because the Examiner has not made sufficient findings to support such a conclusion.

The Examiner is apparently relying on a rationale that one of ordinary skill in the art could have arrived at the claimed subject matter by applying a known technique to the apparatus disclosed in *Nakabayashi* to yield predictable results. Pursuant to M.P.E.P. § 2143(D), to reject claim 1 based on this rationale, the Examiner must articulate the following:

- (1) a finding that the prior art contained a "base" device (method, or product) upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product);

- (3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Applicant respectfully submits that the Examiner has failed to make findings that the prior art contained a known technique applicable to the apparatus disclosed by *Nakabayashi*; and that a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system. Accordingly, the Examiner has not established a *prima facie* case for rejecting claim 1 under Section 103, and the rejection of claim 1 should be withdrawn for at least this reason.

The Examiner asserts "The Office believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement these viewing condition parameters of *Nakabayashi et al.*, which are equivalent to the type block and illuminance block data of the claim in a single data format that comprises lamp type information and luminance level information since manipulation of such data in to a single component/string would be easier to manage, store and access." (Office Action, pp. 4-5, emphasis added, sic.) However, no support is provided in the Office Action for the Examiner's asserted belief.

Moreover, the Office Action does not establish that one of ordinary skill in the art would have recognized that by applying the known technique that it would have yielded predictable results and resulted in an improved system. The Examiner merely asserts that "making the predetermined illumination characteristic data into a data format comprising a type block and an illuminance block," is not disclosed by Applicant as being advantageous or solving a problem. (Office Action, p. 5.) This rationale improperly discounts the recited claim features. "All words in a claim must be considered in judging the patentability of that

claim against the prior art.” (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); M.P.E.P. § 2143.03.) Moreover, it does not demonstrate that an artisan would have recognized the use or benefit of the allegedly known technique. Thus, the rejection under Section 103 is also improper for this reason.

For the reasons above, the Examiner has not established a *prima facie* case for rejecting claim 1 under Section 103. Applicant, therefore, requests that the rejection of claim 1 be withdrawn and the claim allowed.

Claims 19 and 40 recite similar subject matter to that recited in claim 1. Thus, claims 19 and 40 are allowable over the applied reference for the same reasons set forth above with regard to claim 1.

Claims 2-7, 10-18, 20-24 and 42 are also allowable at least due to their corresponding dependence from claims 1, 19 and 40.

Conclusion

For the reasons set forth above, Applicant respectfully requests allowance of the pending claims.

If additional fees are required for any reason, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: **June 3, 2008**

By: /Steven Ashburn/
Steven Ashburn
Registration No. 56,636

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620